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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,904	07/31/2000	Douglas B. Quine	F-179	5048

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EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 01/22/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/629,904

Applicant(s)

QUINE, DOUGLAS B.

Examiner

Djenane M Bayard

Art Unit

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-- Th MAILING DATE of this communication appears on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-32 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to amendment filed on December 09, 2004 in which claims 17-32 and 34 are pending and claims 33 and 35-36 are canceled. The applicant's arguments have been fully considered but are moot in view of the new ground of rejections. Therefore, this action is made final (see Examiner new rejection).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 6,438,583 to McDowell et al in view of U.S. Patent No. 5,805,810 to Maxwell and further in view of U.S. Patent No. 6,075,844 to Goldberg et al.

a. In regard to claim 17, McDowell discloses a method for transmitting an e-mail message comprising the steps of: receiving the e-mail message at an intermediate address, the e-mail message including non-preferred e-mail address data (See col. 1, lines 51-53); parsing the non-preferred e-mail address data from the e-mail message at

the intermediate address and determining if there is preferred e-mail address data associated with the non-preferred e-mail address data (See col. 8, lines 7-11); However, McDowell et al failed to disclose storing at a location associated with intermediate address, the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data.

Maxwell teaches storing at a location the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data. (See col. 1, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate storing at a location associated with intermediate address, the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data as taught by Maxwell into claimed invention of McDowell et al because the intermediate server will be able to complete the delivery of the e-mail message to the recipient when the recipient connects to the network (See col. 1, lines 41-43).

However, McDowell et al in view of Maxwell fails to teach wherein the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address.

Goldberg et al teaches wherein the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address (See col. 7, lines 30-36).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address as taught by Goldberg et al in the claimed invention of McDowell in view of Maxwell in order for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12).

b. In regard to claim 18, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting the e-mail message to the preferred e-mail address when preferred e-mail address data is associated with the non-preferred e-mail address data (See col. 8, lines 7-11).

c. In regard to claim 19, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the method further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message has been sent to the preferred e-mail address (See col. 14, lines 40-43).

d. In regard to claim 20, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of sending a return e-mail message to a sender address from the intermediate address

indicating that the e-mail message was not forwarded to the preferred e-mail address
(See col. 14, lines 40-43)

e. In regard to claim 21, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell discloses a method further comprising indicating to the sender that the intermediate address will withdraw the e-mail message upon receiving a request from the sender address (See col. 12, lines 55-58).

f. In regard to claim 22, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting an e-mail message to the preferred e-mail address indicating that a user at a sender e-mail address is attempting to transmit an e-mail message to the non-preferred e-mail address (See col. 8, lines 41-43).

g. In regard to claim 23, McDowell et al in view of Maxwell discloses the claimed invention as described above. However, McDowell failed to disclose the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data.

Maxwell discloses the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data (See col1, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data as taught by Maxwell into claimed invention of McDowell et al because the intermediate server will be able to complete the delivery of the e-mail message to the recipient when the recipient connects to the network (See col. 1, lines 41-43).

h. In regard to claim 24, McDowell et al discloses a method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address, the method comprising the steps of: receiving the rejected e-mail message at an intermediate address (See col. 8, lines 33); determining a preferred recipient e-mail address from the rejected e-mail message (See col. 8, lines 7-11). However, McDowell et al failed to disclose storing at a location associated with the intermediate address, the previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known recipient e-mail address.

Maxwell discloses storing the e-mail message when the recipient is reachable. (See col. 1, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate storing at a location associated with intermediate address, the previously-known recipient e-mail address when it is determined that there

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is no preferred recipient e-mail address associated with the previously-known recipient e-mail address as taught by Maxwell into claimed invention of Nielsen because the intermediate server will be able to complete the delivery of the e-mail message to the recipient when the recipient connects to the network (See col. 1, lines 41-43).

However, McDowell in view of Maxwell fails to teach wherein the e-mail message is transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message is transmitted back to the sender address (See col. 7, lines 30-35).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message is transmitted back to a sender e-mail address as taught by Goldberg et al in the claimed invention of McDowell in view of Maxwell in order to for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12).

i. In claim 25, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting the e-mail message to the preferred recipient e-mail address when a preferred recipient e-mail address is associated with the previously-known recipient e-mail address (See col. 8, lines 7-11).

g. In regard to claim 26, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the method further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message has been sent to the preferred recipient e-mail address (See col. 12, lines 14-17).

k. In regard to claim 27, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message was not forwarded to the preferred e-mail address (See col. 14, lines 40-43)

l. In regard to claim 28, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell discloses a method further comprising indicating to the sender that the intermediate address will withdraw the e-mail message upon receiving a request from the sender address (See col. 12, lines 55-58).

m. In regard to claim 29, McDowell et al in view of Maxwell discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting an e-mail message to the preferred e-mail address indicating that a user at

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a sender e-mail address is attempting to transmit an e-mail message to the non-preferred e-mail address (See col. 8, lines 41-43).

n. In regard to claim 30, McDowell et al in view of Maxwell discloses the claimed invention as described above. However, McDowell failed to disclose the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data.

Maxwell discloses the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data (See col1, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data as taught by Maxwell into claimed invention of McDowell et al because the intermediate server will be able to complete the delivery of the e-mail message to the recipient when the recipient connects to the network (See col. 1, lines 41-43).

o. In regard to claim 31, McDowell discloses a method for transmitting an e-mail message that was sent from a sender address to a previously-known recipient e-mail address that is associated with a first service provider, and rejected at the previously-known recipient e-mail address (See col. 1, lines 50-53) the method comprising the steps of: receiving the rejected e-mail message at a second address; determining

whether there is a preferred recipient e-mail address, that is associated with a second service provider, from the rejected e-mail message (See col. 8, lines 7-11). However, McDowell et al failed to disclose storing at a location associated with the intermediate address, the previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known e-mail address.

Maxwell discloses storing the e-mail message when the recipient is reachable. (See col. 1, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate storing at a location associated with intermediate address, the previously-known recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known recipient e-mail address as taught by Maxwell into claimed invention of McDowell et al because the intermediate server will be able to complete the delivery of the e-mail message to the recipient when the recipient connects to the network (See col. 1, lines 41-43).

However, McDowell in view of Maxwell fails to teach wherein the e-mail message is transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message is transmitted back to the sender address. (See col. 7, lines 30-35).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message is transmitted back to a sender e-mail address as taught by Goldberg et al in the claimed invention of McDowell

in view of Maxwell in order to for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12).

p. In regard to claim, 32, McDowell et al discloses a method for transmitting an e-mail message that has been sent from a sender address to a second address, the e-mail message including a non-preferred e-mail address associated with a first preferred e-mail address associated with a first service provider (See col. 1, lines 50-53), the method comprising the steps of: receiving the e-mail message at an intermediate address; parsing the e-mail message to obtain the non-preferred e-mail address from the e-mail message; determining whether there is a preferred e-mail address, that is associated with a second service provider, from the non-preferred e-mail address (See col. 8, lines 7-11). However, McDowell et al failed to disclose storing at a location associated with the intermediate address, the non-preferred recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the non-preferred e-mail address.

Maxwell discloses storing the e-mail message when the recipient is reachable. (See col. 1, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate storing at a location associated with intermediate address, the non-preferred recipient e-mail address when it is determined that there is no preferred recipient e-mail address associated with the previously-known recipient e-mail address as taught by Maxwell into claimed invention of McDowell et al because the

intermediate server will be able to complete the delivery of the e-mail message to the recipient when the recipient connects to the network (See col. 1, lines 41-43).

However, McDowell in view of Maxwell fails to teach wherein the e-mail message is transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message is transmitted back to the sender address (See col. 7, lines 30-35).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message is transmitted back to a sender e-mail address as taught by Goldberg et al in the claimed invention of McDowell in view of Maxwell in order to for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12).

4. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,438,583 to McDowell et al in view of U.S. Patent No. 6,405,243 to Nielsen.

a. In regard to claim 34, McDowell et al disclose a method for transmitting an e-mail message comprising the steps of sending a first e-mail message from a sender address to a non-preferred recipient e-mail address; However, McDowell et al failed to disclose receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address, indicating that the non-preferred recipient e-mail address is not preferred and there is not a preferred recipient e-mail address associated with the non-preferred e-mail address.

Nielsen discloses receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address, indicating that the non-preferred recipient e-mail address is not preferred and there is not a preferred recipient e-mail address associated with the non-preferred e-mail address (See col. 6, lines 42-44).

It would have been obvious to one with ordinary skill in the art at the time of the invention was made to incorporate receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address, indicating that the non-preferred recipient e-mail address is not preferred and there is not a preferred recipient e-mail address associated with the non-preferred e-mail address as taught by Nielsen into the claimed invention of McDowell et al in order to update the sender about whether or not the second address has an updated e-mail address for the recipient. (See col. 6, lines 41-42).

(11) Response to Argument

5. In page 10, paragraph 2, applicant asserted McDowell and Nielsen taken alone or in combination fail to teach receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address.

However, the examiner respectfully disagrees with the applicant argument. Indeed, Nielsen teaches receiving, at the sender address, a second e-mail message

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from a second address, which is independent from the non-preferred e-mail address (See rejection above). In addition, by implementing such teaching into McDowell, it would have been obvious to update the sender about whether or not the second address has an updated e-mail address for the recipient. (See col. 6, lines 41-42). Therefore, applicant argument is moot and this case is made final.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Djenane Bayard

Patent Examiner

January 8, 2004


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER